IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Application of

Alan SLATER et al.   Group Art Unit: 3624

U.S. Serial No.: 09/348,529

Filed: July 7, 1999   Examiner: FELTEN, Daniel S.

For: SYSTEM AND METHOD FOR IMAGE DEPOSITING, IMAGE PRESENTMENT
        AND DEPOSIT TAKING IN A COMMERCIAL ENVIRONMENT

APPEAL BRIEF

Commissioner for Patents
U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop **Appeal Brief - Patents**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

This is an Appeal Brief under the new Rules of Practice Before the Board of Patent

Appeals and Interferences, Board Rule 41.37 (Effective September 13, 2004), in connection with

the decisions of the Examiner in a Final Office Action dated October 30, 2003 (hereinafter, "the

Final OA"). Each of the topics required by Board Rule 41.37 is presented herewith and is

labeled appropriately.

(1)   Real Party In Interest

The real party in interest is Citibank, N.A.

(2)   Related Appeals And Interferences

There are no other appeals or interferences related to this case.

(3)   Status Of Claims

Claims 1-11, 13-33, and 35-39 are pending and rejected. Claims 1-11, 13-33, and 35-39 are hereby appealed.

(4)   Status of Amendments

There are no outstanding amendments.

(5)   Summary Of The Invention

The present invention is directed to a system and method for conducting image based transactions. One method of the present invention comprises: receiving at a first location at least one of a check and cash having a front face and a back face (see, e.g., p. 5, lines 28+; FIG. 1, 13); scanning the front face and the back face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash (see, e.g., p. 5, lines 28+; FIG. 1, 13); transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location (see, e.g., p. 6, lines 1+; FIG. 1, 23); and processing a transaction at the second location with the scanned image of the deposited check or electronic validation of deposited cash, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location (see, e.g., p. 9, lines 8+; FIG. 4, 258).

One system of the present invention comprises: 24. A system for conducting image based transactions, comprising: means for accepting as a deposited item at a first location at least one of a check and cash having a front face and a back face (see, e.g., p. 5, lines 28+; FIG. 1, 13); a scanner located at a first location and configured for scanning the front face and the back face of at least one of the check and cash, for creating an image of a deposited check or deposited cash (see, e.g., p. 6, lines 16+); means for transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location (see, e.g., p. 6, lines 1+; FIG. 1, 23); means for receiving the transmitted image of the scanned deposited check or electronic validation of deposited cash, said means for receiving being located at the second location (see, e.g., p. 9, lines 8+; FIG. 4, 258); and means for processing a transaction with the image of the scanned deposited check or electronic validation of deposited cash at the second location, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location (see, e.g., p. 9, lines 8+; FIG. 4, 258).

(6)   Grounds of Rejection Presented for Review

a) Claims 1-11, 13-33, and 35-49 stand rejected under 35 USC 103(a) as being unpatentable over US Patent Number 5,590,196 to Moreau ("Moreau") in view of US Patent Number 5,282,050 to Ishizuka et al. ("Ishizuka").

(7)   Arguments

The rejection of claims 1-11, 13-33, and 35-49 under 35. U.S.C. § 103(a) as being

unpatentable is not proper

In a previous Non-final Office Action (hereinafter, "the NOA") dated February 3, 2003, the

Examiner asserted that:

> Re claims 1, 24, 40 and 45:
> Moreau discloses an apparatus and method for image based transactions (see Moreau Abstract), comprising:
> receiving at a first location at least one instrument and cash having a front and back face;
> scanning, with a scanner (fax machine or facsimile),to create a deposited instrument or an electronic validation of deposited cash (see Moreau, col. 1, 11. 46-59);
> transmitting an image, with image transmitting means (fax machine or facsimile), of the scanned deposited instrument or cash from the first location to a second location (see Moreau, 12 col. 6, 11. 47 to col. 7, 11. 13); and
> transmitting an image of the scanned deposited instrument or cash from the first location to a second location (see col. 6, 11. 47 to col. 7, 11. 13); and
> processing a transaction at the second location with the scanned image of the deposited instrument or electronic validation of deposited cash, without verification of the signature of a user initiating the transaction in the case of a deposited instrument, which signature is used to verify that the user is a profiled user with a specified system, whereby pickup of said at least one of an instrument and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location (see col. 6, 11. 47 to cot. 7, 11. 13).
> Moreau fails to disclose scanning the front and back face of at least one instrument and/or cash.
> Ishizuka discloses a fax machine with the ability to scan both sides of a document (see Ishizuka, figs. 2 and 10, Abstract; and col. 1, 11. 33 to col. 2, 11. 19). It would have been obvious for an artisan of ordinary skill at the time of the invention to substitute the fax machine of Moreau for the dual scanning fax machine of Ishizuka because an artisan at the time of the invention would have considered them art recognized equivalents having no unexpected features to one of ordinary skill in the art.
> Furthermore, an artisan or ordinary skill in the art would have recognized the convenience of integrating a dual scanning fax machine into the Moreau system to provide the ability to scan documents with print on both sides. Thus such a modification would have been an obvious expedient to one of ordinary skill in the art.

In response, an Amendment (hereinafter, "the Amendment") was filed on August 3,

2003, respectfully traversing the rejection of independent claims 1, 24, 40, and 45 under 35 USC

103(a) as being unpatentable over Moreau in view of Ishizuka, as recited below:

Regarding claim 1, the cited art, neither singularly nor in combination, teach or suggest,

"A method for image based transactions, comprising: receiving at a first location at least one of a

check and cash having a front face and a back face; scanning the front face and the back face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash; transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location; and processing a transaction at the second location with the scanned image of the deposited check or electronic validation of deposited cash, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location" as recited in claim 1 of the present application. Specifically, the cited art, neither singularly nor in combination, teach or suggest the steps of "receiving at a first location at least one of a check and cash having a front face and a back face; scanning the front face and the back face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash," as required in claim 1 of the present application (emphasis added).

As admitted by the Examiner, "Moreau fails to disclose scanning the front and back face of at least one instrument and/or cash." Moreau discloses a secure payment method using facsimile which uses a business payment form 203. Moreau does not teach or suggest that the business payment form is a check or cash. Moreover, Ishizuka is only cited as disclosing "a fax machine with the ability to scan both sides of a document. Therefore, the cited art, neither singularly nor in combination, teach or suggest the steps of "receiving at a first location at least one of a check and cash having a front face and a back face; scanning the front face and the back face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash," as required in claim 1 of the present application (emphasis added).

Pursuant to the requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. §103, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Referring to MPEP Section 2142,

> [t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(emphasis added). Thus, since the cited art, neither singularly nor in combination, teach or suggest the steps of "receiving at a first location at least one of a check and cash <u>having a front face and a back face</u>; scanning <u>the front face and the back face</u> of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash," as required in claim 1 of the present application (emphasis added),the Examiner has failed to establish a *prima facie* case of obviousness.

Moreover, since the business payment forms disclosed in Moreau are neither checks nor cash, the business payment forms do not need the front and back sides scanned, thus there is no motivation to combine Moreau and Ishizuka.

For at least these reasons, independent claim 1, as well as dependent claims 2-11 and 13-23 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

Regarding independent claim 24, the cited art does not teach or suggest "A system for conducting image based transactions, comprising: means for accepting as a deposited item at a first location at least one of a check and cash <u>having a front face and a back face</u>; a scanner

located at a first location and configured for <u>scanning the front face and the back face of at least</u> <u>one of the check and cash,</u> for creating an image of a deposited check or deposited cash; means for transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location; means for receiving the transmitted image of the scanned deposited check or electronic validation of deposited cash, said means for receiving being located at the second location; and means for processing a transaction with the image of the scanned deposited check or electronic validation of deposited cash at the second location, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location" as required in claim 24 of the present application (emphasis added).

Thus, as stated above with respect to claim 1, the cited art, neither singularly nor in combination, teach or suggest a scanner configured for "scanning the front face and the back face of at least one of the check and cash," thus the Examiner has failed to establish a *prima facie* case of obviousness. Moreover, as stated above, there is no motivation to combine Moreau and Ishizuka.

For at least these reasons, claim 24, as well as dependent claims 25-33 and 35-39 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

Regarding independent claim 40, the cited art does not teach or suggest "A method for image based transactions, comprising: receiving at a first location at least one of a check and cash <u>having a front face and a back face; scanning the front face and the back face of said at least</u>

one of the check and cash to create a deposited check or an electronic validation of deposited cash; transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location; and processing a transaction at the second location with the scanned image of the deposited check or electronic validation of deposited cash without verification of the signature of the user initiating the transaction in the case of a deposited check, which signature is used to verify that the user is a profiled user with a specified system, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location" as required in claim 40 of the present application (emphasis added)..

Thus, as stated above with respect to claim 1, the cited art, neither singularly nor in combination, teach or suggest the step of "scanning the front face and the back face of at least one of the check and cash," thus the Examiner has failed to establish a *prima facie* case of obviousness. Moreover, as stated above, there is no motivation to combine Moreau and Ishizuka.

For at least these reasons, claim 40, as well as dependent claims 41-44 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

Regarding independent claim 45, the cited art does not teach or suggest "A system for conducting image based transactions, comprising: means for accepting as a deposited item at a first location at least one of a check and cash having a front face and a back face; a scanner located at a first location and configured for scanning the front face and the back face of at least

one of the check and cash, for creating an image of a deposited instrument or deposited cash; means for transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location; means for receiving the transmitted image of the scanned deposited check or electronic validation of deposited cash, said means for receiving being located at the second location; and means for processing a transaction with the image of the scanned deposited check or electronic validation of deposited cash at the second location without verification of the signature of a user initiating the transaction in the case of a deposited instrument, which signature is used to verify that the user is a profiled user within a specified system, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location" as required in claim 45 of the present application (emphasis added).

Thus, as stated above with respect to claim 1, the cited art, neither singularly nor in combination, teach or suggest a scanner configured for "scanning the front face and the back face of at least one of the check and cash," thus the Examiner has failed to establish a *prima facie* case of obviousness. Moreover, as stated above, there is no motivation to combine Moreau and Ishizuka.

For at least these reasons, claim 45, as well as dependent claims 46-49 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

In response to the aforementioned arguments, the Examiner issued the Final OA, asserting that:

It is apparent that applicant fails to recognize the level of ordinary skill in the art or to appreciate how

references where [sic] evaluated by what the cited in prior art would suggest to one versed in the art rather than their specific disclosure.... The main advantage of Moreau's invention is to provide smooth migration from a paper based payment system (i.e. paper check) to electronic payment system (see Moreau, col. 8, ll. 52+). *The value transfer form is viewed as an art recognized equivalent to a check because it functions in the same manner...*" *See* Final OA, p. 3 (emphasis added).

As admitted by the Examiner, Moreau's invention is to provide a smooth migration from a paper based payment system (i.e., paper check) to electronic payment system. That is why Moreau introduces the use of *business payment forms* instead of *paper checks* and thus actually teaches away from the use of checks and scanning the front and back faces of such checks. Therefore, there is no motivation to combine Moreau and Ishizuka to show the front and back scanning of *checks*. Furthermore, as stated in MPEP 2144.06,

> In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958)...

It is respectfully submitted that the alleged equivalence is not recognized in the prior art, as at least evidence by Moreau, which distinguishes payment forms from paper checks and prefer to use the payment forms over the check. Furthermore, the Examiner has not set forth any evidence to show the alleged recognized equivalence in the prior art, except for Moreau which appears to contradict such alleged recognized equivalence.

Regarding each and every one of the dependent claims 2-11, 13-23, 25-33, 34-39, 41-44, and 46-49, the Examiner has not set forth any evidence to reject these claims except for the general allegation that they are rejected under 35 USC1 103(a) by Moreau in view of Ishizuka. Therefore, it was not possible to submit arguments against such rejection. Furthermore, a review of Moreau and Ishizuka fails to show any evidence that Moreau and/or Ishizuka anticipate or make obvious the claimed invention set out in each of claims 2-11, 13-23, 25-33, 34-39, 41-44, and 46-49.

Therefore, it is respectfully submitted that, separately, each of these claims is allowable over the references of record.

Conclusion

For at least the reasons given above, the rejections of claims 1-11, 13-33, and 35-49 are improper. It is respectfully requested that such rejections by the Examiner be reversed and these claims be allowed. Attached below for the Board's convenience is an Appendix of claims 1-11, 13-33, and 35-49 as currently pending.

Respectfully submitted,

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(9)   Appendix

1.   A method for image based transactions, comprising:

receiving at a first location at least one of a check and cash having a front face and a back face;

scanning the front face and the back face of said at least one of the check and cash to create a deposited check or an electronic validation of deposited cash;

transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location; and

processing a transaction at the second location with the scanned image of the deposited check or electronic validation of deposited cash, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location.

2.   The method of claim 1, wherein said processing comprises crediting a deposit in the amount of the check to a customer's account.

3.   The method of claim 2, further comprising displaying an image of the scanned at least one of the check and cash on a terminal display at the first location to provide confirmation to a customer that the deposit has been accepted.

4.   The method of claim 1, wherein the scanning is conducted on the check and further comprising recreating the image of the scanned deposited check onto paper.

5.   The method of claim 4, wherein said recreating of the check onto paper further comprises cutting the paper to the size of a check.

6.   The method of claim 5, wherein said recreating of the check onto paper is done at the second location.

7.   The method of claim 1, wherein said first location is an automatic teller machine, owned and operated by a bank for its customers, having a scanner and display, and the method further comprising storing the scanned at least one of the check and cash in the automatic teller machine.

8.   The method of claim 4, further comprising recreating the scanned deposited check into a paper image which is Magnetic Image Character Recognition (MICR) encoded.

9.   The method of claim 1, further comprising separately entering the amount on the at least the check and cash which has been scanned, comparing the amount entered with the amount scanned, and if the scanned amount matches the entered amount, conducting the processing of the transaction.

10.   The method of claim 1, further comprising composing, encrypting and digitally signing the check before the transmission to the second location for processing.

11.   The method of claim 1, wherein said first location is an automatic teller machine, owned and/or operated by someone other than the owner of the second location.

13.   The method of claim 1, wherein said first location is a branch of a bank.

14.   The method of claim 1, wherein said first location is a retail business location.

15.   The method of claim 1, wherein said first location is a business.

16.   The method of claim 1, wherein said first location is outside the United States.

17.   The method of claim 1, further comprising voiding said check at the first location by printing on the check or destroying the check.

18.   The method of claim 1, further comprising endorsing the check.

19.   The method of claim 9, further comprising transmitting the image to another location to display to an operator for resolution if the amounts entered and scanned differ.

20. The method of claim 1, further comprising comparing the information on the check to information contained in a file of indicators of potential loss.

21. The method of claim 1, further comprising maintaining a file of payor bank preferences for how the payor bank will receive presentment, and processing the transaction in accordance with the preferences.

22. The method of claim 21, further comprising using the information in the payor bank preference file to determine whether presentment will be by paper, Extended Capabilities Port (ECP), image, or Automatic Clearing House (ACH).

23. The method of claim 1, further comprising maintaining a file of routing preferences, and processing the transaction in accordance with the preferences.

24. A system for conducting image based transactions, comprising:

means for accepting as a deposited item at a first location at least one of a check and cash having a front face and a back face;

a scanner located at a first location and configured for scanning the front face and the back face of at least one of the check and cash, for creating an image of a deposited check or deposited cash;

means for transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location;

means for receiving the transmitted image of the scanned deposited check or electronic

validation of deposited cash, said means for receiving being located at the second location; and

means for processing a transaction with the image of the scanned deposited check or

electronic validation of deposited cash at the second location, whereby pickup of said at least one

of the check and cash received at the first location can be delayed or eliminated, resulting at least

in cost savings or improvements in payment settlement times by processing the transaction with

the scanned image at the second location.

25.   The system of claim 24, further comprising means for processing a transaction with the

same information as if the original was available.

26.   The system of claim 25, wherein said means for processing is for crediting a deposit in

the amount of a the scanned check to a customer's account.

27.   The system of claim 26, further comprising a display located at the first location for

displaying an image of a scanned at least one of the check and cash, for providing visual

confirmation to a customer that the deposit has been accepted.

28.   The system of claim 24, further comprising a printer adapted for recreating the check as

an image on paper, and composited with machine readable regenerated Magnetic Image

Character Recognition (MICR) encoding of the original check's Magnetic Image Character

Recognition (MICR) code line data.

29.   The system of claim 28, wherein said printer is located at the second location.

30.   The system of claim 24, further comprising an automatic teller machine having said scanner thereon at the first location, and having a secured container region therein for storing scanned checks or cash in the automatic teller machine.

31.   The system of claim 28, wherein said printer is capable of recreating the scanned image into a paper image which is Magnetic Image Character Recognition (MICR) encoded, and composited with machine-readable regenerated Magnetic Image Character Recognition (MICR) encoding of the original check's Magnetic Image Character Recognition (MICR) code line data

32.   The system of claim 24, further comprising means for separately entering the amount on an at least one of an instrument and cash which has been scanned; and means for comparing the account entered with the amount scanned for allowing transmission to conduct processing of the transaction.

33.   The system of claim 24, further comprising means for compressing, encrypting and digitally signing the scanned at least one of the check and cash before transmission to the second location for processing.

35.   The system of claim 24, wherein said second location has means for sending the information it receives to a third location for processing within or for another bank.

36.   The system of claim 24, wherein the second location has means for sending the information it receives to the Federal Reserve Bank or one of its offices or a clearinghouse as a third location, and the third location has means for creating the images on paper and Magnetic Image Character Recognition MICR encodes them for entry into the check processing system or sending the information to a bank for payment.

37.   The system of claim 24, further comprising means at the second for sending the information it receives directly to the payor bank or its processing agent or correspondent for payment.

38.   The system of claim 24, further comprising a device having said scanner thereon at the first location, and having a secured container region therein for storing scanned checks or cash at a branch of a bank.

39.   The system of claim 24, further comprising a device having said scanner thereon at the first location, and having a secured container region therein for storing scanned checks or cash at a business.

40.   A method for image based transactions, comprising:

receiving at a first location at least one of a check and cash having a front face and a back

face;

scanning the front face and the back face of said at least one of the check and cash to

create a deposited check or an electronic validation of deposited cash;

transmitting an image of the scanned deposited check or electronic validation of

deposited cash from the first location to a second location; and

processing a transaction at the second location with the scanned image of the deposited

check or electronic validation of deposited cash without verification of the signature of the user

initiating the transaction in the case of a deposited check, which signature is used to verify that

the user is a profiled user with a specified system, whereby pickup of said at least one of the

check and cash received at the first location can be delayed or eliminated, resulting at least in

cost savings or improvements in payment settlement times by processing the transaction with the

scanned image at the second location.

41.   The method of claim 1, wherein said transaction is cashing the check.

42.   The method of claim 40, wherein said transaction is depositing the check amount in a

user's account.

43.   The method of claim 40, wherein said transaction is making a purchase at a vendor, with

the vendor location being said first location.

44.　　The method of claim 40, wherein said transaction is conducted between unrelated systems, wherein said first location is part of one network and said second location is part of a second network.

45.　　A system for conducting image based transactions, comprising:

　　　　means for accepting as a deposited item at a first location at least one of a check and cash having a front face and a back face;

　　　　a scanner located at a first location and configured for scanning the front face and the back face of at least one of the check and cash, for creating an image of a deposited instrument or deposited cash;

　　　　means for transmitting an image of the scanned deposited check or electronic validation of deposited cash from the first location to a second location;

　　　　means for receiving the transmitted image of the scanned deposited check or electronic validation of deposited cash, said means for receiving being located at the second location; and

　　　　means for processing a transaction with the image of the scanned deposited check or electronic validation of deposited cash at the second location without verification of the signature of a user initiating the transaction in the case of a deposited instrument, which signature is used to verify that the user is a profiled user within a specified system, whereby pickup of said at least one of the check and cash received at the first location can be delayed or eliminated, resulting at least in cost savings or improvements in payment settlement times by processing the transaction with the scanned image at the second location.

46. The system of claim 45, wherein said system is configured for conducting cashing of the check.

47. The system of claim 45, wherein said system is configured for conducting a deposit of the check amount in a user's account.

48. The system of claim 45, wherein said first location is a vendor location, said second location is a bank location, and said system is configured to allow making a purchase at the vendor location.

49. The system of claim 45, wherein said first location is part of one network and said second location is part of a second network.